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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/668,196	09/22/2000	Stephen James Russell	18093/1130	9873
26191	7590	02/07/2006	EXAMINER	
FISH & RICHARDSON P.C. PO BOX 1022 MINNEAPOLIS, MN 55440-1022			LUCAS, ZACHARIAH	
			ART UNIT	PAPER NUMBER
			1648	

DATE MAILED: 02/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/668,196	Applicant(s) RUSSELL ET AL.	
	Examiner Zachariah Lucas	Art Unit 1648	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9,11-22,24,26,28-30 and 33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7,9,11-22,24,26,28-30 and 33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of the Claims

1. Claims 1-7, 9, 11-22, 24, 26, 28-30, and 33 are pending and under consideration in the present action.
2. In the prior action, mailed on July 6, 2005, claims 1-7, 9, 11-22, 24, 26, 28-30, and 33 were pending and rejected.

A Response to the office action was submitted on January 6, 2006.

Specification

3. **(Prior Objection- Withdrawn)** The disclosure was objected to because of certain informalities in the specification. In view of the amendment of the application to correct the informalities, the objection is withdrawn.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. **(Prior Rejection- Maintained)** Claims 1-7, 9, 11-22, 24, 26, 28, 29, and 33 were rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the claimed methods for reducing the number of viable cancer cells in a mammal comprising the

Art Unit: 1648

administration of Edmonston Measles Virus strains identified in the present application, does not reasonably provide enablement for methods of reducing cancer cells using any attenuated Measles Virus. In traversal of this rejection, the Applicant submits an assertion the application is sufficiently enabling for the full scope of the claimed invention, and that no undue experimentation would be required. However, the Applicant has presented no evidence or reasoning in support of the assertion.

Because the Examiner has presented evidence and reasoning in support of the rejection, and because attorney argument does not substitute for evidence or take the place of evidence in the record, and as the Applicant has presented no evidence in support of their assertion, the argument is not found persuasive. The rejection is therefore maintained for the reasons of record.

6. **(Prior Rejection- Maintained)** Claims 1-7, 9, 11-22, 24, 26, 28, 29, and 33 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. In traversal of this rejection, the Applicant asserts that those in the art “would not have concluded, as the Examiner has done, that the art is no unpredictable that the present claims lack written description.” The Applicant then asserts that the specification provides examples and teachings relating to the claimed invention sufficient to provide adequate descriptive support for the claimed genus. However, the Applicant does not relate to any specific teachings of the application to resolve the uncertainties described in the prior action. Nor does the Applicant provide anything more than a mere assertion that the teachings of the application resolve the uncertainties of which the Examiner provided evidence of in the prior action. In view of the fact that Applicant has provided no evidence in support for their assertion that the application

Art Unit: 1648

provides adequate descriptive support for what is being claimed, and because attorney argument does not substitute for evidence or take the place of evidence in the record, the arguments set forth are not found persuasive. The rejection is therefore maintained for the reasons of record.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **(Prior Rejection- Maintained)** Claims 1-7, 9, 11-17, 20-22, 24, 26, and 28-30, and 33 were rejected in the prior action under 35 U.S.C. 103(a) as obvious over the teachings of Bateman et al. in view of Usonis et al. (Ped Inf Dis J 18:42-48), and further in light of the teachings of Linardakis, the Bateman abstract, Taqi, Bluming, and Johnston. The Applicant traverses the rejection on two grounds. First, the Applicant asserts that the teachings of the prior art fails to teach or suggest the administration of an attenuated measles virus for the treatment of a cancer. Second, the Applicant asserts that the application discloses unexpected results over the teachings of the prior art. These arguments are not found persuasive.

It is first noted that the Applicant's response makes the above assertions without providing any evidence or reasoning in support thereof. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a

Art Unit: 1648

patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Further, the Examiner nowhere asserts that any one of the references teach or suggest the use of an attenuated measles virus for the treatment of a cancer or tumor. However, for the reasons described in the actions of November 17, 2003 and the prior action (mailed July 6, 2005) the Applicant's assertions are not found persuasive. The rejection is therefore maintained for the reasons of record.

9. **(Prior Rejection- Maintained)** Claims 16 and 17 were rejected in the prior action under 35 U.S.C. 103(a) as obvious over the teachings of Bateman et al. in view of Usonis in view of either Asada (Cancer 34: 1907-28, of record in the IDS filed on Jan 5, 2001) or Sato et al (Int J Oral Surg 8:205-11, of record in the IDS filed on July 12, 2002) and further in view of the teachings and suggestions of Linardakis, the Bateman abstract, Taqi, Bluming, and Johnston. The Applicant provides no arguments in traversal of this rejection over those described above. Thus, this rejection is also maintained for the reasons of record.

10. **(Prior Rejection- Maintained)** Claims 18 and 19 were rejected in the prior action under 35 U.S.C. 103(a) as obvious over the teachings of Bateman et al., in view of Usonis, further in view of Duprex (J Virol 73: 9568-75), and in light of the teachings of Linardakis, the Bateman abstract, Taqi, Bluming, and Johnston. The Applicant provides no arguments in traversal of this rejection over those described above. Thus, this rejection is also maintained for the reasons of record.

11. **(Prior Rejection- Maintained)** Claim 20 was rejected in the prior action under 35 U.S.C. 103(a) as obvious over the teachings of either Galanis et al. (Gene Therapy 6 (Supp 1): S7, abstract 28) or Russell et al. (Proc. Am Assoc Cancer Res 41: 259, abstract 1648) in view of Usonis, and further in light of the teachings of Linardakis, the Bateman abstract, Taqi, Bluming, and Johnston. The Applicant provides no arguments in traversal of this rejection over those described above. Thus, this rejection is also maintained for the reasons of record.

12. **(Prior Rejections- Withdrawn)** Claims 1-7, 9, 11-15, 18-21, 24, 28-30, and 33 were rejected under 35 U.S.C. 103(a) as being obvious over Russell et al. (Russell patent, U.S. 6,896,881). Claims 16 and 17 were rejected under 35 U.S.C. 103(a) as being unpatentable over the Russell patent as applied to claims 1-7, 9, 11-15, 18-21, 24, 28-30, and 33 above, and further in view of Usonis and Weibel. In the prior action, it was noted that the Russell patent has a common inventor and assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). In traversal of the rejection, the Applicant has submitted a statement that the invention of the present application was commonly owned by, or subject to an obligation of assignment to, the same entity. In view of the statement, which removes the patent as prior art under 35 U.S.C. § 103(c), the rejection is withdrawn.

Double Patenting

Art Unit: 1648

13. **(Prior Provisional Rejection- Withdrawn)** Claims 1, 18, and 19 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 11/125,940. The Applicant traverses the provisional rejection on the basis that claim 1 of the copending application has been cancelled. In view of the amendment of the copending application, the rejection is withdrawn.

Conclusion

14. No claims are allowed.

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

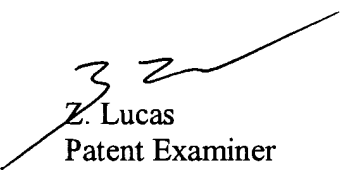
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zachariah Lucas whose telephone number is 571-272-0905. The examiner can normally be reached on Monday-Friday, 8 am to 4:30 pm.

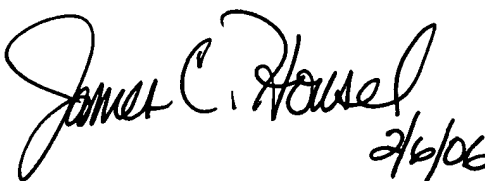
Art Unit: 1648

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel can be reached on 571-272-0902. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Z. Lucas
Patent Examiner



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SUPERVISORY PATENT EXAMINER
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